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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,125	04/29/2002	Norman Bitterlich	F-7241	5539
28107	7590	02/27/2006	EXAMINER	
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			SIMS, JASON M	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/009,125	Applicant(s) BITTERLICH, NORMAN	
	Examiner Jason M. Sims	Art Unit 1631	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached further explanation. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-5.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
of reasons of record as explained further as attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

DETAILED ACTION

Applicant's arguments, filed 01/17/2006, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Further Explanation of Item 3

Claim 1, part e) amendment, raises the issue of New Matter by changing the data used to calculate a similarity dimension from using "available reference values" to using "all reference values." This change in scope, not previously disclosed in the specification constitutes New Matter. The specification only refers to "reference values that are available." See paragraphs 1, 0018, and 0049.

Claim 1, part f) amendment raises the issue of New Matter by changing the number of factors, which the calculation to determine a mathematical similarity is depended, from two, the first and second similarity dimensions, to one, a similarity dimension.

The amendment in response to the rejection of claims 1-5 under 35 U.S.C. 112, first paragraph, over the vague and indefinite definition for the parameter "k," raises the issue of New Matter. The new range of values for k, previously determined to range from $k=1$ to K , have broadened the range from $k = 0$, stated as $k-1$, to K . The broadening of the range of values for the parameter k constitutes New Matter.

Claim 1, part b) amendment raises the issue of New Matter. The specification does not disclose normalizing measured values with respect to a first measured value for each bone marker, but with respect to a first line in a table of measured values.

Further Explanation of Item 11

Claim 1, part c) rejection under 35 U.S.C. 112 second paragraph is maintained.

"In claim 1, part c), lines 4-5, the modification, "wherein W_1, W_2, \dots, W_k , are weighting factors and, in a standard determination, $W_k = 1$," necessitated by amendment, clearly states the role of W_k as a weighting factor. However, there remains a lack of definition for a set of values and what determines/ influences this set of values for W_k , which causes the claim to remain vague and indefinite. For example, although a standard determination for $W_k = 1$ is set forth in the claim, what is an acceptable range of values for W_k and what determines or influences this range of values is not set forth in the claim? Clarification via clearer claim wording is requested. Claims, which depend from claim 1, also lack this clarity due to their dependence from claim 1."

Claim 1, part g) rejection under 35 U.S.C. 112 second paragraph is maintained.

"In claim 1, part g), lines 4-5, the modification, "wherein $R_j(t)$ are reference functions for describing the anticipated course of the bone density loss for the type I," necessitated by amendment, sets forth that $R_j(t)$ are reference functions, but does not define a set of values for, or what influences, said reference functions. A review of the specification has not revealed a definition of what is meant by said reference functions. Therefore a lack of definition of what

determines the values of $R_j(t)$ causes the claim to be vague and indefinite.

Evaluation of these values is required in order to calculate the $R_j(t)$ values.

Clarification via clearer claim wording is requested. Claims, which depend from claim 1, also lack clarity due to their dependence from claim 1."

The amendment to the Specification would overcome the objection to the Specification made in the Final Office Action on 10/14/2005 if the After Final Amendment was entered.

The amendment after final rejection filed on 01/17/2006 has not been entered.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Sims, whose telephone number is 1-571-272-7540.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ardin Marschel can be reached via telephone 1-571-272-0718.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The Central PTO Fax Center number is 1-571-273-8300.

Any inquire of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is 1-571-272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 1631

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ardin H. Marschel 2/21/06
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER